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| 09/358,280      | 07/21/1999  | STEVEN M. UTTER      | MISTY-52064         | 1354             |

7590 01/22/2003

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EXAMINER

KIM, CHRISTOPHER S

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3752

DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/358,280

Applicant(s)

UTTER, STEVEN M. 

Examiner

Christopher S. Kim

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-- Th MAILING DATE of this communication app ars on the cover sh et with th correspondenc addr ss --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5-12 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-12 and 15-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 16 December 2002 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 16, 2002 has been entered. Amendment filed November 18, 2002 remains un-entered because it appears to be a duplicate of the amendment filed December 16, 2002.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

3. Newly submitted claim 22 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the process as claimed can be practiced by another materially different apparatus which does not require the alligator clip of claims 5 and 11; the apparatus as claimed (in claim 18) can be used to practice another and materially different process which does not require manipulating a valve

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 22 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

4. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on December 16, 2002 have been disapproved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

The proposed drawing changes do not appear to show and corrections. It only contains a bracket, bracketing the two figures together. This change does not appear to affect the drawing.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "aperture" recited in claim 21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 21 recites "an aperture size small enough to emit fluid as particles having a size characteristic of an evaporative mist." The specification as originally filed fails to teach any particular "size" aperture.

***Claim Rejections - 35 USC § 102***

7. Claims 18, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Cushing (4,911,339).

Cushing discloses an apparatus comprising: a pressurizable container 16; a manual pump 40; a means for delivering fluid (spray nozzle) 20; a means for controlling the emission of evaporative mist (valve) 46; a first conduit 72; a second conduit 18, 51; a means for hands-free directing (clip) 24.

***Claim Rejections - 35 USC § 103***

8. Claims 5, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing (4,911,339) in view of Rosenberg (4,960,419).

With respect to claims 5 and 8, Cushing discloses an apparatus comprising: a pressurizable container 16; a first water conduit 72; means 40 for pressurizing the container; a second water conduit 18, 51; a spray nozzle 20; a clip 24; a restrictive valve

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46; and a means for sealing 70. The valve of Cushing inherently has an open position and a closed position. Cushing differs from what is being claimed in the alligator clip. The clip of Cushing is a C-shaped clip. Rosenberg discloses, in column 6, lines 3-6, a conventional alligator clip 235 for securing a tube to a convenient point. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have replaced the clip of Cushing with the alligator clip of Rosenberg for attachment to convenient places.

With respect to claim 10, Cushing in view of Rosenberg discloses the limitations of the claimed invention with the exception of ice. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have added ice to the container of Cushing in view of Rosenberg to dispense cold water.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing (4,911,339) in view of Rosenberg (4,960,419) as applied to claim 5 above, and further in view of Shurnick et al. (4,852,781).

Cushing in view of Rosenberg differs from what is claimed in the means secured to the misting apparatus for attaching the misting apparatus to a person's waist. Shurnick et al. discloses a means 27 for securing a bottle to a part of a person's body (waist shown in figure 1). It would have been obvious to a person having ordinary skill in the art at the time of the invention to have replaced cage 30 of Cushing with the means 27 of Shurnick et al. to attach the device of Cushing to a runner.

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10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing (4,911,339) in view of Rosenberg (4,960,419) as applied to claim 5 above, and further in view of Norman (842,689).

Cushing in view of Rosenberg discloses the limitations of the claimed invention with the exception of the manual piston type pump. Norman discloses a piston pump 7, 11, 12, 13, 17. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have replaced the bellows pump of Cushing with the piston pump of Norman to provide faster compression.

11. Claims 11, 12 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing (4,911,339) in view of Rosenberg (4,960,419), Shurnick et al. (4,852,781) and Roueche et al. (5,186,391).

With respect to claims 11, 12, 15 and 16,

Cushing discloses an apparatus comprising: a pressurizable container 16; a first water conduit 72; means 40 for pressurizing the container; a second water conduit 18, 51; a spray nozzle 20; a clip 24; a restrictive valve 46; and a means for sealing 70. The valve of Cushing inherently has an open position and a closed position. Cushing differs from what is being claimed in: the means for pressurizing the container mounted to the inlet; the means for securing the container to the person; and the alligator clip.

Roueche et al. discloses, in figure 13, a piston pump mounted to an inlet cap 118. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have replaced the bellows pump of Cushing with the piston pump of Roueche et al. to provide faster compression.

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Shurnick et al. discloses a means 27 for securing a bottle to a part of a person's body (shown as a belt 27 around runner's waist 31 in figure 1). It would have been obvious to a person having ordinary skill in the art at the time of the invention to have replaced cage 30 of Cushing with the means 27 of Shurnick et al. to attach the device of Cushing to a runner.

Rosenberg discloses, in column 6, lines 3-6, a conventional alligator clip 235 for securing a tube to a convenient point. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have replaced the clip of Cushing with the alligator clip of Rosenberg for attachment to convenient places.

With respect to claim 17,

Cushing in view of Rosenberg, Shurnick et al. and Roueche et al. discloses the limitations of the claimed invention with the exception of ice. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have added ice to the container of Cushing in view of Rosenberg, Shurnick et al. and Roueche et al. to dispense cold water.

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing Cushing (4,911,339) in view of Shurnick et al. (4,852,781).

Cushing differs from what is claimed in the means secured to the misting apparatus for attaching the misting apparatus to a person's waist. Shurnick et al. discloses a means for securing 27 for securing a bottle to a part of a person's body (waist shown in figure 1). It would have been obvious to a person having ordinary skill

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in the art at the time of the invention to have replaced cage 30 of Cushing with the belt-like fastener 27 of Shurnick et al. to attach the device of Cushing to a runner.

### ***Response to Arguments***

13. Applicant's arguments filed December 16, 2002 have been fully considered but they are not persuasive.

In response to applicant's statement that figure 3 has been added, the amendment does not appear to include a figure 3.

In response to applicant's argument that claim 21 is supported by the specification, the specification fail to teach what constitutes "small enough."

In response to applicant's argument that Cushing does not disclose "for generating an evaporative mist, useful for evaporatively cooling an individual", recitation of intended use has not been given patentable weight. Additionally, Cushing discloses such use in column 1, line 15.

In response to applicant's argument that Cushing does not disclose a "means for hands free direction", Cushing discloses a means for hands-free directing (clip) 24.

In response to applicant's argument that Cushing does not disclose a fine spray, Cushing discloses a spray (inherent in a sprayer). The term "fine" is a relative term and is considered to be met by Cushing.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Cushing discloses a clamp which requires a screw drive for installation of screw 62. Rosenberg discloses that alligator clips are conventional (readily known to one of ordinary skill in the art). One of ordinary skill in the art would have recognized that an alligator clip does not require any installation tool and therefore makes for easy attachment of the nozzle in the device of Cushing.

In response to applicant's argument that Rosenberg is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Cushing and Rosenberg are both related to the particular problem of clamps/clips.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Kim whose telephone number is (703) 308-8336. The examiner can normally be reached on Monday - Thursday, 6:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (703) 308-2087. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7766 for regular communications and (703) 308-7766 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Christopher S. Kim  
Examiner  
Art Unit 3752

CK  
July 15, 2002